

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA COMPANY)	
)	
Opposer,)	
)	Opposition No. 91161373
v.)	
)	Mark: BARILLA - AMERICA'S
)	FAVORITE PASTA
)	
BARILLA G.E.R. Fratelli Societa Per)	Application No. 78/136,703
Azioni)	
Applicant.)	Published: March 23, 2004

OPPOSITION TO APPLICANT'S MOTION FOR EXTENSION OF TIME

Opposer objects to the Motion for Extension of Time to extend discovery by two days to November 3, 2005 two days after the close of discovery on November 1, 2005, as unnecessary and unsupported by the requisite showing of good cause. Moreover, the facts demonstrate that Applicant has had ample opportunity to conduct discovery in this matter and that the granting of the Motion would prejudice Opposer by giving Applicant an unfair advantage in this proceeding.

It should be noted that Opposer is not unsympathetic to Applicant's reasonable requests and when contacted by counsel for the Opposer on October 3, 2005, consented to the motion to extend the time to answer the amended opposition. See Applicant's Motion of October 4, 2005. Opposer's counsel had also consented to an earlier extension of discovery on May 6, 2005. See Applicant's submission of 9 May 2005. Further, Opposer's counsel consented to an extension to file the initial Answer as reflected by the

11-09-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #34

Page 1 of 4

TTAB

I hereby certify that this document is being deposited
with the United States Postal Service as first class mail
in an envelope addressed to the Commissioner for
Trademarks, P.O. Box 1451, Alexandria, Virginia 22313,
on this 7th day of November, 2005.
HOVEY WILLIAMS LLP

BY

[Signature]

filing of August 27, 2004. Here, however, the on the deadline filing for a further extension of discovery is abusive and unwarranted.

In the Motion submitted by Applicant, the justification for the additional two days is stated to be an automobile accident suffered by counsel for Applicant on October 18, 2005, and Opposer is sympathetic to any such injury sustained by Applicant's attorney. However, several unstated facts demonstrate that this is not a sufficient reason to extend discovery in this case:

- 1) Two other lawyers have been involved in this case from the same firm representing Applicant: G. Franklin Rothwell and Robert H. Cameron have both been actively involved in this case in addition to Carla Calcagno. In fact, the attached Firm Profile and list of attorneys demonstrates that a number of attorneys are available to assist Mr. Rothwell if Ms. Calcagno is injured.
- 2) In addition to the Motion filed November 1, 2005, Applicant filed its Third Set of Requests for the Production of Documents and Things (Nos. 23-27), its Fourth Set of Requests for Admission Nos. 21-37, and Applicant's Third Set of Interrogatories (Nos. 20-33). See Exhibits 1-3 hereto.
- 3) Applicant has had ample opportunity for timely presentation of discovery requests since this matter commenced in the summer of 2004.

It is evident from the foregoing discovery requests served on November 1 that counsel for Applicant had the knowledge and ability to serve its discovery within the deadlines imposed by the amended Scheduling Order, as Applicant served a number of such discovery requests on time. Notwithstanding her injury, it appears that it did not in

any way impair counsel from serving three discovery requests on time on the last day. However, without consulting Opposer, it now seeks an extension of two days only for the purpose of submitting additional discovery requests in the form of eight additional interrogatories, 44 requests for admission and 11 requests for the production of documents and things. See Exhibits 4-6 attached. Responding to such untimely discovery requests imposes unwarranted burdens on the party which follows the Rules and the scheduling order. The axiom that equity favors the diligent means that in light of the practice employed by Applicant here, leave to file additional discovery after the deadline should not be granted.

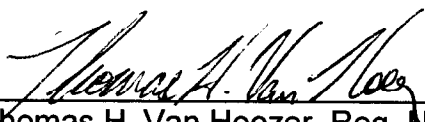
Applicant was well able to exercise its ability to serve discovery on November 1, and it is clear that there is no justification as to why the November 3 discovery could not have been timely served. Moreover, granting Applicant the additional two days, which has now expired, amounts to an ex post facto extension giving all the benefit to one side with no corresponding notice that the extension so requested actually favors only one party – the only one which knew on November 1 that further extension was requested and set it for such a short period that only the moving party could benefit. Such a practice is manifestly unfair and prejudicial to the non-moving party which follows the Rules and the schedule imposed by the Board.

Accordingly, Opposer respectfully requests that the Motion for Extension of Time be denied.

Respectfully submitted,

HOVEY WILLIAMS LLP

By

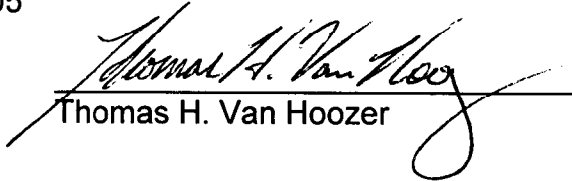

Thomas H. Van Hoozer, Reg. No. 32,761
Cheryl Burbach
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
816/474-9050

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposition to Applicant's Motion for Extension of Time was mailed this 7th day of November, 2005 by first class mail, postage prepaid, addressed to the attorney for Applicant at the following address:

G. Franklin Rothwell
Carla C. Calcagno
Rothwell, Figg, Ernst & Manbeck
1425 K Street, NW, Suite 800
Washington, D.C. 20005


Thomas H. Van Hoozer



ROTHWELL, FIGG, ERNST & MANBECK, P.C.
IP Professionals

Firm Profile



Our firm is engaged in the practice of intellectual property law on a worldwide basis. Intellectual property law encompasses what formerly was termed "patent, trademark and copyright law," as well as related areas such as trade secrets and unfair competition. In addition to the traditional legal services in this area, which involve securing intellectual property protection, rendering opinions and providing advice on activities within the intellectual property law field, we provide professional services in related litigation, licensing, contract and other matters which involve intellectual property law. Our firm is one of the best known and highly regarded patent litigation firms in the United States, having handled a large number of complex and high profile patent litigations. We also provide advice and representation with respect to First Amendment and defamation issues.

We are a professional corporation which includes not only the shareholders, but other lawyers who range in experience from those who have practiced in the field for 50 years to attorneys newly admitted to the bar who typically have several years of experience as law clerks in intellectual property law.

Our firm's patent practice is directed primarily toward clients engaged in sophisticated technological areas, such as the biotechnology and pharmaceutical fields; computer hardware and software and the Internet; semiconductors; advanced electronics; medical devices; and a wide variety of mechanical systems and devices. We also have a significant trade identity practice, representing clients in the fields of trademarks, service marks, trade names, unfair competition, character protection, and the like. Although our firm has special expertise in connection with intellectual property litigation, a significant aspect of our practice is devoted to obtaining patents, obtaining trademark and copyright registrations, and licensing and counseling.

All of the attorneys in our firm who are involved in technological areas have a scientific or engineering education in addition to their legal education and bar admission. Additionally, all attorneys who solicit patents before the Patent and Trademark Office are registered patent attorneys.

We consider our most important asset to be the people in our office, including our fine staff. Our lawyers are aided by trained legal assistants (paralegals), technical advisors, law clerks and experienced legal secretaries who work together with the lawyers to ensure prompt and economical delivery of requested professional services.

We serve a wide variety of clients who range from large multi-national corporations to individual businessmen and women. Our clients are located throughout the United States and in other countries. Almost all of our new clients are referrals from existing clients.

Our firm also deals with intellectual property matters, including prosecution and litigation matters, in foreign countries. Our practice includes obtaining patents and registering trademarks through the use of foreign associate attorneys and agents with whom we have had long-standing professional relationships.

Our guiding principle is to provide the highest quality professional services on a timely basis at a reasonable charge. Our professional fees usually are based on the actual amount of time expended on a project, which generally is determined by the difficulty of the project. It is our practice to apportion projects or parts of projects among persons in the office who are capable of performing the work at the lowest billing rate. We often find that utilizing the assistance of well-trained paralegals is cost-effective for our clients.

We generally bill our clients in the subsequent month when a significant amount of services are rendered during the previous month. When requested, we can and do give advance estimates of expected costs.

We recognize that our clients must be kept informed regularly of the progress of the matters they have entrusted to us. Our firm has a policy of regular client communication in which the client is provided with periodic information and copies of appropriate documents concerning the progress of each case.

We use "state-of-the-art" equipment and systems for communicating, word processing, docketing and billing, to enable us to render the finest possible services cost-effectively and responsively to the client's requirements.

If requested, the firm can provide a list of representative clients in any of our areas of expertise. Prior to accepting any new client, the firm carefully checks to be sure there are no conflicts of interest.

1425 K Street, N.W. Suite 800 Washington, D.C. 20005 (202) 783-6040 Fax: (202) 783-6031
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IP Professionals

Attorneys

Practice Areas

Counseling

Copyright

Licensing & Transactions

Litigation

Patent Prosecution

Trade Dress

Trademarks, Collective Marks, Service Marks

Unfair Competition

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- Joseph A. Hynds
- Jeffrey L. Ihnen
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- Patrick T. Skacel
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- Brian A. Tollefson
- Adam M. Treiber
- Barbara Webb Walker, Ph.D.
- Richard Wydeven
- Martin M. Zoltick

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- Joseph A. Hynds
- Jeffrey L. Ihnen
- Glenn E. Karta
- Joo Mee Kim
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- Hyunkweon Ryu
- Patrick T. Skacel
- Brian A. Tollefson
- Adam M. Treiber
- Barbara Webb Walker, Ph.D.
- Richard Wydeven
- Martin M. Zoltick

Trade Dress

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- Anne M. Sterba
- Richard Wydeven

Trademarks, Collective Marks, Service Marks

- Minaksi Bhatt
- Carla C. Calcagno
- C. Nichole Gifford
- Robert B. Murray
- George R. Repper
- G. Franklin Rothwell
- Anne M. Sterba
- Brian A. Tollefson
- Richard Wydeven

Unfair Competition

- R. Elizabeth Brenner
- Carla C. Calcagno
- G. Franklin Rothwell
- Anne M. Sterba
- Brian A. Tollefson
- Richard Wydeven

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA
COMPANY,

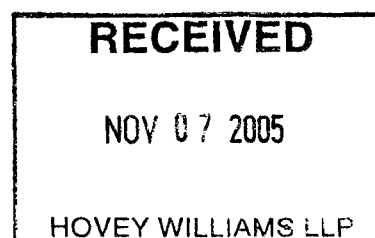
Opposer

v.

BARILLA G. E R. FRATELLI- SOCIETA
PER AZIONI,

Applicant.

Opposition No. 91-161,373



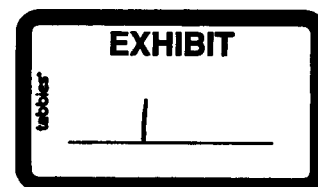
**APPLICANT'S THIRD SET OF REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice in Trademark cases under 37 CFR §2.116, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests Opposer, American Italian Pasta Company ("AIPC"), to produce for inspection and copying the documents designated below at the offices of Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Carla C. Calcagno, within thirty (30) days of the service hereof or at such other time and place as the parties agree.

Definitions and Instructions

For purposes of these requests, Applicant adopts the Definitions and Instructions in Applicant's Third Set of Interrogatories to Opposer

For the convenience of the parties and the Board, each Request for Production should be quoted in full immediately preceding the response.



REQUESTS

Request No. 23:

Produce all documents in Opposer's possession, custody and control which Opposer contends support Opposer's claim that Applicant lacks or lacked a bona fide intent to use the Opposed Mark.

Request No. 24:

Produce all documents in Opposer's possession, custody and control, which Applicant did not produce, and which Opposer contends support Opposer's claim that Applicant lacks or lacked a bona fide intent to use the Opposed Mark.

Request No. 25:

Produce all documents in Opposer's possession, custody or control, which Opposer contends reflect consumer understanding of, or the significance of, or the degree of consumer recognition of the phrase AMERICA'S FAVORITE PASTA.

Request No. 26:

Produce all studies, surveys or scientific reports which Opposer contends reflect consumer understanding of, or the significance of, or the degree of consumer recognition of the phrase AMERICA'S FAVORITE PASTA.

Request No. 27:

Produce all studies, surveys or scientific reports which Opposer contends reflect the degree of likelihood of confusion between Opposer's use of the phrase AMERICA'S FAVORITE PASTA and Applicant's proposed use of Barilla – America's Favorite Pasta.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: 

G. Franklin Rothwell

Carla C. Calcagno

ROTHWELL, FIGG, ERNST & MANBECK P.C.

1425 K Street, NW, Suite 800

Washington, DC 20005

Telephone: (202) 783-6040

Facsimile: (202) 783-6031

Attorneys for the Applicants

Dated: November 1, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 1ST day of NOVEMBER, 2005, I served the foregoing
APPLICANT'S THIRD SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS
AND THINGS by causing a true copy thereof to be sent, in the manner indicated, to the
following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Matthew Felten

docreq3

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**AMERICAN ITALIAN PASTA)
COMPANY,)

Opposer)

v.)

Opposition No. 91-161,373

BARILLA G. E R. FRATELLI - SOCIETA)
PER AZIONI)

Applicant.)

RECEIVED

NOV 07 2005

HOVEY WILLIAMS LLP

APPLICANT'S FOURTH SET OF REQUESTS FOR ADMISSION NOS. 21-37

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, as incorporated into the Trademark Rules of Practice, Applicant, Barilla G.E R. Fratelli - Societa Per Azioni ("Barilla"), propounds the following Requests for Admission to Opposer, American Italian Pasta Company ("AIPC") for which responses are to be served on Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Carla C. Calcagno, Esq., within thirty (30) days of the service hereof.

For purposes of these Requests, Applicant adopts the Definitions and Instructions in Applicant's Third Set of Interrogatories to Opposer.

For the convenience of the parties and the Board, each Request for Admission should be quoted in full immediately preceding the response.

EXHIBIT2

REQUESTS

Request No. 21:

Admit that Opposer's sole bases for its claim that Applicant lacks a bona fide intention to use the Opposed Mark is that Applicant filed more than one application for the same goods and allegedly produced no documents evidencing its bona fide intention to use.

Request No. 22:

Admit that other than the facts recited in Applicant's Admission Request No. 21, Opposer presently has no documentary evidence to support its claim that Applicant lacks or at any time lacked a bona fide intention to use the Opposed mark.

Request No. 23

Admit that Opposer has interviewed no persons who can provide factual testimony that Applicant lacks or at any time lacked a bona fide intention to use the Opposed Mark.

Request No. 24

Admit that during Civil Action No. 02-0594 CV-W-SOW, entitled American Italian Pasta Company v New World Pasta Company, Opposer admitted that the phrase AMERICA'S FAVORITE PASTA is puffery.

Request No. 25

Admit that during Civil Action No. 02-0594 CV-W-SOW, entitled American Italian Pasta Company v New World Pasta Company, Opposer argued that the phrase AMERICA'S FAVORITE PASTA is puffery.

Request No. 26

Admit that during Civil Action No. 02-0594 CV-W-SOW, entitled American Italian Pasta Company v New World Pasta Company, Opposer admitted that the phrase AMERICA'S FAVORITE PASTA is laudatory.

Request No. 27

Admit that during Civil Action No. 02-0594 CV-W-SOW, entitled American Italian Pasta Company v New World Pasta Company, Opposer argued that the phrase AMERICA'S FAVORITE PASTA is laudatory.

Request No. 28

Admit that Opposer through its predecessors in interest have not used the mark or designation AMERICA'S FAVORITE PASTA continuously on its packaging since 1997.

Request No. 29

Admit that Opposer through its predecessors in interest have used the mark or designation AMERICA'S FAVORITE PASTA continuously on its packaging only since 1997.

Request No. 30

Admit that Opposer through its predecessors in interest have used the mark or designation AMERICA'S FAVORITE PASTA continuously on its packaging since 1997.

Request No. 32

Admit that Opposer through its predecessors in interest have not used the mark or designation AMERICA'S FAVORITE PASTA continuously on its promotional materials since May 31, 1989.

Request No. 33

Admit that Opposer through its predecessors in interest have used the mark or designation AMERICA'S FAVORITE PASTA continuously on its promotional materials only since May 31, 1989.

Request No. 34

Admit that Opposer through its predecessors in interest have used the mark or designation AMERICA'S FAVORITE PASTA continuously on its promotional materials since May 31, 1989.

Request No. 35

Admit that Opposer has produced no documents consisting of marketing studies, surveys or scientific reports directly reflecting U.S. consumer recognition of the phrase "AMERICA'S FAVORITE PASTA" as identifying source in Opposer.

Request No. 36

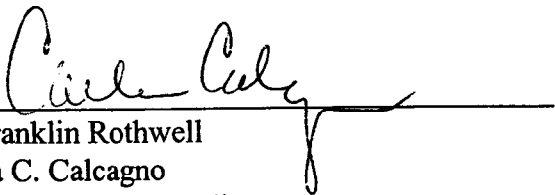
Admit that Opposer has produced no documents directly reflecting the percentage of consumers who recognize the phrase "AMERICA'S FAVORITE PASTA" as identifying source in Opposer

Request No. 37

Admit that Oppose is aware that other companies use or have used the phrase
"AMERICA'S FAVORITE" followed by a descriptive or generic term in connection with the
sale or offering of food products

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: 
G. Franklin Rothwell
Carla C. Calcagno
Attorneys for the Applicant
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
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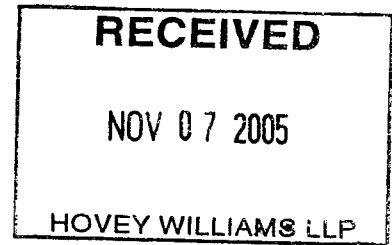
Dated: Jan. 1, 2005

CERTIFICATE OF SERVICE

I hereby certify that on November 1, 2005, I served the foregoing APPLICANT'S
FOURTH SET OF REQUESTS FOR ADMISSIONS NOS. 21-37 by causing a true copy thereof
to be sent, via first class mail, postage prepaid to the following address:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Matthew Felten



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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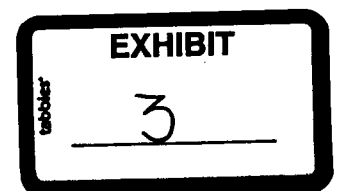
The logo consists of a small square containing the letter 'C' followed by the letters 'COP' in a bold, sans-serif font.

Opposition No. 91-161,373

APPLICANT'S THIRD SET OF INTERROGATORIES

Pursuant to Rules 33 of the Federal Rules of Civil Procedure and Rule 2.120 of the Trademark Rules of Practice, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests that Opposer, American Italian Pasta Company ("AIPC"), serve upon Applicant sworn answers to the interrogatories set forth below at the offices of Rothwell, Figg, Ernst & Manbeck, 1425 K Street, N.W., Suite 800, Washington, D.C. 20005, within thirty (30) days after the service hereof. These discovery requests are intended to be continuing in nature and any information or related materials which may be discovered subsequent to the service and filing of the answers should be brought to the attention of the Applicant through supplemental answers within a reasonable time following such discovery.

For the convenience of the Board and the parties, Applicant requests that each discovery request (including subparts) be quoted in full immediately preceding the response.



DEFINITIONS AND INSTRUCTIONS

- a. The word "person" or "entity" shall mean and include without limitation, individuals, firms, associations, partnerships, and corporations.
- b. The term "Opposer", "AIPC," "you" or "your" shall mean American Italian Pasta Company, its predecessors-in-interest, licensees and any affiliated or related companies having any involvement with the use of the term, mark, or slogan "AMERICA'S FAVORITE PASTA" as defined below, and shall include, individually or collectively, its partners, officers, directors, employees, agents or representatives.
- c. In the following discovery requests, the term "document" or "documents" is used in its customary broad sense to mean all non-identical copies of all documents within the scope of Rule 34, Fed. R. Civ. P., including, without limitation, reports and/or summaries of interviews; reports and/or summaries of investigations; opinions or reports of consultants; opinions of counsel; communications of any nature including internal company communications; memoranda; notes; letters; e-mail; agreements; reports or summaries of negotiations; brochures; pamphlets; advertisements; circulars; trade letters; press releases; drafts of documents and revisions of drafts of document and any written, printed, typed or other graphic matter of any kind of nature; drawings; photographs; charts; electronically stored data; and all mechanical and electronic sound recordings or transcripts thereof, in the possession and/or control of Opposer or its employees or agents, or known to Opposer to exist, and shall include all non-identical copies of documents by whatever means made and whether or not claimed to be privileged or otherwise excludable from discovery. By way of illustration only and not by way of limitation, any

documents bearing on any sheet or side thereof any marks, including, but not limited to, initials, stamped indicia, comment or notation of any character and not a part of the original text or any reproduction thereof, is to be considered a separate document. In the case of a machine readable document, identify the specifications and/or common name of the machine on which the document can be read such as "VHS videotape, MS DOS (IBM) PC using WordPerfect 5.1" or the like.

d. In the following discovery requests, where identification of a document is required, such identification should describe the document sufficiently so that it can be specifically requested under Rule 34 of the Federal Rules of Civil Procedure and should include without limitation the following information, namely:

- i. the name and address of the author;
- ii. the date;
- iii. the general nature of the document, i.e., whether it is a letter, memorandum, pamphlet, report, advertising (including proofs), etc.;
- iv. the general subject matter of the documents;
- v. the name and address of all recipients of copies of the documents;
- vi. the name and address of the person now having possession of the original and the location of the original;
- vii. the name and address of each person now having possession of a copy of and the location of each such copy;

viii. for each document Opposer contends is privileged or otherwise excludable from discovery, the basis or such claim of privilege or other grounds for exclusion; and

ix. whether Opposer is willing to produce such document voluntarily to Barilla for inspection and copying.

e. In the following discovery requests, where identification of a person, as defined, is required, state:

i. the person's full name, state of incorporation, if any, present and/or last known home address (designating which), present and/or last known position or business affiliation (designating which) and/or present or last known (designating which) affiliation with Opposer, if any. In the case of a present or past employee, officer or director or agent of Opposer, also state the person's period of employment or affiliation with Opposer, and his or her present or last position during his affiliation with Opposer.

f. In the following discovery requests, where identification of an oral communication is required, state the date, the communicator, the recipient of the communication, and the nature of the communication.

g. All references in these discovery requests to Opposer's Mark means the term, mark or slogan "AMERICA'S FAVORITE PASTA", *per se*, as shown in Application Serial No. 76/497,489, and all variations thereof, whether printed in all capital letters, all lower case letters, or a mixture of capital and lower case letters, in any size or style of font, and whether standing alone or in conjunction with other words, numbers, symbols, or designs, including, but not limited to, an American Flag.

h. Whenever used herein, the term "&" shall be deemed to include the term "and" and the term "n"; the singular shall be deemed to include the plural, the plural shall be deemed to include the singular; the masculine shall be deemed to include the feminine and the feminine shall be deemed to include the masculine; the disjunctive ("or") shall be deemed to include the conjunctive ("and"), and the conjunctive ("and") shall be deemed to include each of the other functional words.

i. The terms "state" or "describe" (as used with respect to the specific interrogatories below) shall mean to set forth and/or identify with particularity all evidence or other information available to Opposer concerning the matter, to identify each person with knowledge and to identify all communications and documents concerning the subject matter.

j. The term "Applicant's mark" or "Mark" shall refer to the mark BARILLA – AMERICA'S FAVORITE PASTA that is the subject matter of Application No. 78/136,703.

INTERROGATORIES

Interrogatory No. 20

State by years, or for periods less than one year, by month any periods during which Opposer and/or its predecessor in interest(s) failed to use any mark or designation consisting of or including the phrase "AMERICA'S FAVORITE PASTA" in connection with the advertising, marketing, distribution, or promotion of pasta products.

Interrogatory No. 21

For each of Applicant's Fourth Set of Request for Admissions, served concurrently herewith, to which Opposer responds with anything other than an unqualified admission, state all

facts and either identify by bates number all documents previously produced, or produce all documents not yet produced, supporting Opposer's failure to admit the requested information.

Interrogatory No. 22

Identify by bates numbers all documents previously produced which Opposer contends consist of marketing studies, surveys or scientific reports directly reflecting U.S. consumer recognition of the phrase "AMERICA'S FAVORITE PASTA" as a phrase identifying source in Opposer.

Interrogatory No. 23

Identify by bates numbers all documents previously produced which Opposer contends directly reflect U.S. consumer recognition of the phrase "AMERICA'S FAVORITE PASTA" as a phrase identifying source in Opposer.

Interrogatory No. 24

Identify by bates numbers all documents previously produced which Opposer contends reflect that Applicant lacked or lacks a bona fide intention to use the Opposer Mark in commerce

Interrogatory No. 25

Identify all persons upon whose statements or testimony Opposer may rely to prove that Applicant lacks or lacked a bona fide intention to use the Opposed Mark.

Interrogatory No. 26

State facts sufficient for Applicant to determine the alleged facts forming the evidentiary basis for Opposer's claim that Applicant lacks or lacked a bona fide intention to use the Opposed Mark (e.g. multiple applications).

Interrogatory No. 27

State whether Opposer has communicated with any person, other than Applicant's outside counsel, presently or previously employed by or affiliated with Applicant regarding whether or not Applicant possessed or possesses a bona fide intent to use the Opposed Mark. Provide the dates on which such communications occurred, the person with whom Opposer communicated and the facts allegedly disclosed by the interviewee during that communication.

Interrogatory No. 28

Identify all persons upon whose statements or testimony Opposer relied to plead that Applicant lacks or lack a bona fide intention to use the Opposed Mark.

Interrogatory No. 29

Identify all persons whom Opposer contends can provide factual testimony that Applicant lacks or lacked a bona fide intention to use the Opposed Mark

Interrogatory No. 30

Identify all persons whom Opposer has interviewed and whom Opposer contends can provide factual testimony that Applicant lacks or lacked a bona fide intention to use the Opposed Mark

Interrogatory No. 31

Identify all persons of whom Opposer is aware who are knowledgeable as to whether or not Applicant lacks or lacked a bona fide intention to use the Opposed Mark.

Interrogatory No. 32

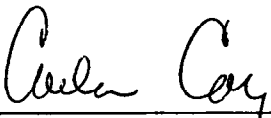
Identify all persons of whom Opposer is aware outside of any person presently employed by Applicant that Opposer contends is knowledgeable that Applicant lacks or lack a bona fide intention to use the Opposed Mark

Interrogatory No. 33

Identify all persons upon whose statements or testimony Opposer relied to plead that Applicant lacks or lack a bona fide intention to use the Opposed Mark

Respectfully submitted,

BARILLA G.E.R. FRATELLI - SOCIETA PER AZIONI

By: 

Carla C. Calcagno
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: November 1, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 1st day of November, 2005, I served the foregoing
APPLICANT'S THIRD SET OF INTERROGATORIES by causing a true copy thereof to be
sent, in the manner indicated, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Matthew Felten

2

INTERROGATORIES

Interrogatory No. 34

For each calendar year since 1997 for which Opposer claims use of the mark AMERICA'S FAVORITE PASTA, state the dollar amount expended specifically promoting the phrase AMERICA'S FAVORITE PASTA.

Interrogatory No. 35

For each calendar year since 1997 for which Opposer claims use of the mark AMERICA'S FAVORITE PASTA, state by dollar and unit volume the number of Mueller's brand pasta packages sold that displayed the phrase AMERICA'S FAVORITE PASTA.

Interrogatory No. 36

For each calendar year since 1997 for which Opposer claims use of the mark AMERICA'S FAVORITE PASTA, state the percentage of packages of Mueller's brand pasta sold that displayed the phrase AMERICA'S FAVORITE PASTA.

Interrogatory No. 37

For each calendar year prior to 1997 for which Opposer claims use of the mark AMERICA'S FAVORITE PASTA, state the dollar amount expended promoting the phrase AMERICA'S FAVORITE PASTA.

Interrogatory No. 38

For each calendar year prior to 1997 for which Opposer claims use of the mark AMERICA'S FAVORITE PASTA, state by dollar and unit volume the number of Mueller's brand pasta packages sold that displayed the phrase AMERICA'S FAVORITE PASTA.

Interrogatory No. 39

For each calendar year prior to 1997 for which Opposer claims use of the mark AMERICA'S FAVORITE PASTA, state the percentage of packages of Mueller's brand pasta sold that displayed the phrase AMERICA'S FAVORITE PASTA.

Interrogatory No. 40

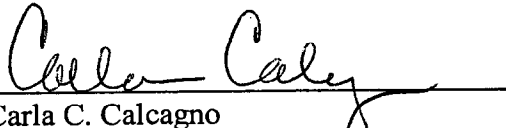
State by Bates number(s), the documents Opposer has produced in this case that list the amount of monies Opposer has spent to specifically promote the phrase AMERICA'S FAVORITE PASTA, apart from the term Mueller's.

Interrogatory No. 41

Identify by title of publication, or by radio or television station call sign and geographic location, and by dates of publication, all nationally circulated advertisements in which Opposer or another on Opposer's behalf has advertised or promoted the phrase AMERICA'S FAVORITE PASTA.

Respectfully submitted,

BARILLA G.E.R. FRATELLI - SOCIETA PER AZIONI

By: 
Carla C. Calcagno
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: November 3, 2005

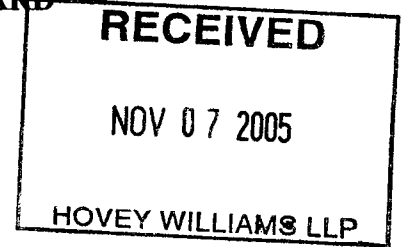
CERTIFICATE OF SERVICE

I hereby certify that on the 3rd day of November, 2005, I served the foregoing
APPLICANT'S FOURTH SET OF INTERROGATORIES by causing a true copy thereof to be
sent, in the manner indicated, to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Matthew Felten

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**



AMERICAN ITALIAN PASTA
COMPANY,

Opposer

v.

BARILLA G. E R. FRATELLI - SOCIETA
PER AZIONI

Applicant.

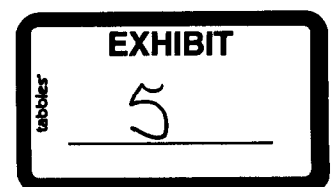
Opposition No. 91-161,373

APPLICANT'S FIFTH SET OF REQUESTS FOR ADMISSION NOS. 38-82

Pursuant to Rule 36 of the Federal Rules of Civil Procedure, as incorporated into the Trademark Rules of Practice, Applicant, Barilla G.E R. Fratelli - Societa Per Azioni ("Barilla"), requests that Opposer, American Italian Pasta Company ("AMERICAN ITALIAN PASTA COMPANY") admit each of the following Requests for Admissions. Responses are to be served on Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Carla C. Calcagno, Esq., within thirty (30) days of the service hereof.

For purposes of these Requests, Applicant adopts the Definitions and Instructions in Applicant's Third Set of Interrogatories to Opposer.

For the convenience of the parties and the Board, each Request for Admission should be quoted in full immediately preceding the response.



REQUESTS

Request No. 38:

Admit that attached at Exhibit A is a true and accurate copy of the Western District of Missouri's decision denying New World Pasta Company's Motion for Partial Summary Judgment in *American Italian Pasta Company v. New World Pasta Company*, Civil Action No. 02-0594-CV-W-SOW (hereafter referred to as "Court's Order on Summary Judgment").

Request No. 39

Admit that from 1997 through November of 2000, American Italian Pasta Company manufactured Mueller's dried pasta for Best Foods.

Request No. 40

Admit that in 2000, American Italian Pasta Company purchased the exclusive rights to own all aspects of the Mueller's pasta business.

Request No. 41

Admit that the phrase "America's Favorite Pasta" has appeared continuously on Mueller's pasta packaging since November of 2000.

Request No. 42

Admit that by dollar volume and unit volume, Barilla sold the most dried pasta in the United States in 2002.

Request No. 43

Admit that in the Court's Order on Summary Judgment, the Court stated: "There is a dispute between the parties as to whether or not the phrase "America's Favorite Pasta" was used

on packages of Mueller's brand pasta between 1997 and 2000 while American Italian Pasta Company was manufacturing the pasta for Best Foods."

Request No. 44

Admit that Mueller's brand pasta is not sold anywhere west of the Mississippi River.

Request No. 45

Admit that in the Court's Order on Summary Judgment, the Court stated: "Viewed in context, the phrase "America's Favorite Pasta" is the kind of general claim of superiority that is "so vague, it would be understood as a mere expression of opinion."

Request No. 46

Admit that Exhibit B is a true and accurate copy of American Italian Pasta Company's Suggestions in Opposition to New World Pasta's Motion for Partial Summary Judgment, which American Italian Pasta Company submitted in Civil Action No. 02 0594 CV-W-SOW.

Request No. 47

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: "The following answers from the Wind Survey to Q4 a-c demonstrates that the phrase "America's Favorite Pasta" is an ambiguous, non-specific self laudatory phrase of public acceptance (Volume II – Wind Survey)."

Request No. 48

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: "AMERICAN ITALIAN PASTA COMPANY seeks to have this Court find as a matter of law, that the slogan "America's Favorite Pasta" is 'puffery.'"

Request No. 49

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: "If "America's Favorite Pasta" is a specific factual statement, it is generic. "A generic word can never function as a trademark to indicate origin. The terms 'generic' and 'trademark' are mutually exclusive, since the function of a mark is to identify and distinguish the goods or services of one seller from those of all others."

Request No. 50

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: "The Slogan is Puffery."

Request No. 51

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: "The self-laudatory phrase is in widespread use in many fields by both merchants and consumers . . .".

Request No. 52

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: " 'America's Favorite' is a self-laudation or mere puffery used by many third parties to claim general superiority for their products, and is not actionable."

Request No. 53

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: "the advertising slogan at issue is self-laudatory or 'puffery.'"

Request No. 54

Admit that in Civil Action No. 02 0594 CV-W-SOW, American Italian Pasta Company argued that: "the answers to the Wind Survey demonstrate the ambiguously laudatory or boastful character of the phrase."

Request No. 55

Admit that attached as Exhibit C is a true and accurate copy of the Affidavit of William M. Weilbacher and supporting exhibits, submitted by American Italian Pasta Company in Civil Action No. 02 0594 CV-W-SOW.

Request No. 56

Admit that attached as Exhibit D is a true and accurate copy of the Affidavit of Darren M. Geliebter and supporting exhibits, submitted by American Italian Pasta Company in Civil Action No. 02 0594 CV-W-SOW.

Request No. 57

Admit that attached as Exhibit E is a true and accurate copy of the Affidavit of Timothy S. Webster in Opposition to New World Pasta's Motion for Partial Summary Judgment, and supporting exhibits, submitted by American Italian Pasta Company in Civil Action No. 02 0594 CV-W-SOW.

Request No. 58

Admit that attached as Exhibit F is a true and accurate copy of New World Pasta's Suggestions in Opposition to American Italian Pasta Company's Motion to Dismiss and

Suggestions in Support of New World Pasta's Motion for Partial Summary Judgment in Civil
Action No. 02 0594 CV-W-SOW.

Request No. 59

Admit that attached as Exhibit G is a true and accurate copy of Consumer Perceptions of
the Phrase "America's Favorite Pasta": Reply Declaration of Yoram (Jerry) Wind in Support of
New World Pasta's Reply Suggestions in Support of Its Motion for Partial Summary Judgment,
submitted by New World Pasta Company in Civil Action No. 02 0594 CV-W-SOW.

Request No. 60

Admit that attached as Exhibit H is a true and accurate copy of the Declaration of Forrest
A. Hainline III and exhibits Supporting New World Pasta's Suggestions in Opposition to
American Italian Pasta Company's Motion to Dismiss and Suggestions in Support of New World
Pasta's Motion for Partial Summary Judgment, submitted by New World Pasta Company in Civil
Action No. 02 0594 CV-W-SOW.

Request No. 61

Admit that the "Volume Sales" and "Dollar Sales" listed in the document attached hereto
as Exhibit I for Mueller's Pasta are accurate.

Request No. 62

Admit that "Share of Dollar Sales" listed in the document attached hereto as Exhibit J for
Mueller's Pasta are accurate.

Request No. 63

Admit that attached hereto as Exhibit K is a true and accurate copy of the Declaration of Lloyd E. Oliver and supporting exhibits submitted by New World Pasta Company in Civil Action No. 02 0594 CV-W-SOW.

Request No. 64

Admit that American Italian Pasta Company's dollar volume of sales of Mueller brand pasta products sold in connection with the mark AMERICA'S FAVORITE PASTA have declined each year since 2000.

Request No. 65

Admit that American Italian Pasta Company's dollar volume of sales of Mueller brand pasta products sold in connection with the mark AMERICA'S FAVORITE PASTA have declined each year since 2001.

Request No. 66

Admit that American Italian Pasta Company's dollar volume of sales of Mueller brand pasta products sold in connection with the mark AMERICA'S FAVORITE PASTA have declined each year since 2002.

Request No. 67

Admit that AMERICAN ITALIAN PASTA COMPANY has used the phrase AMERICA'S FAVORITE PASTA on packages of Mueller's brand pasta continuously only since November of 2003.

Request No. 68

Admit that American Italian Pasta Company claims the exclusive right to use the phrase AMERICA'S FAVORITE PASTA as a trademark in connection with pasta products.

Request No. 69

Admit that American Italian Pasta Company's dollar volume of sales of Mueller brand pasta products sold in connection with the mark AMERICA'S FAVORITE PASTA have declined each year since 1997.

Request No. 70

Admit that American Italian Pasta Company's unit volume of sales of Mueller brand pasta products sold in connection with the mark AMERICA'S FAVORITE PASTA have declined each year since 1997.

Request No. 71

Admit that, by dollar volume, American Italian Pasta Company sold fewer pasta packages bearing the mark AMERICA'S FAVORITE PASTA in 2004, than in 2000.

Request No. 72

Admit that by dollar volume, in 2004, American Italian Pasta Company sold fewer pasta packages bearing the mark AMERICA'S FAVORITE PASTA than in 2002.

Request No. 73

Admit that by dollar volume, in 2004, American Italian Pasta Company sold fewer pasta packages bearing the mark AMERICA'S FAVORITE PASTA than in 2003.

Request No. 74

Admit that by unit volume, in 2004, American Italian Pasta Company sold fewer pasta packages bearing the phrase AMERICA'S FAVORITE PASTA than in 2001.

Request No. 75

Admit that by unit volume, in 2004, American Italian Pasta Company sold fewer pasta packages bearing the phrase AMERICA'S FAVORITE PASTA than in 2002.

Request No. 76

Admit that by dollar volume, in 2004, American Italian Pasta Company sold fewer pasta packages bearing the mark AMERICA'S FAVORITE PASTA than in 2003.

Request No. 77

Admit that the document marked Bates No. U 02311 and attached hereto as Exhibit L shows marketing expenses directed to the Mueller's Brand.

Request No. 78

Admit that the marketing expenses listed in the document marked Bates No. U 02311 and attached hereto as Exhibit L, shows marketing expenses directed solely to the promotion of the phrase AMERICA'S FAVORITE PASTA.

Request No. 79

Admit that Opposer has not yet produced any documents listing the monies Opposer spent to promote the phrase AMERICA'S FAVORITE PASTA only.

Request No. 80

Admit that between 2000 and the filing of this Opposition, neither Opposer nor another acting on Opposer's behalf has promoted or advertised the phrase AMERICA'S FAVORITE PASTA in any nationally distributed newspaper or magazine.

Request No. 81

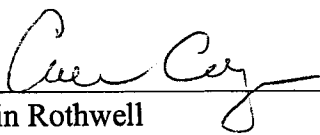
Admit that between 2000 and the filing of this Opposition, neither Opposer nor another acting on Opposer's behalf has distributed any advertising or promotional material bearing the phrase AMERICA'S FAVORITE PASTA to areas of the United States west of the Mississippi River.

Request No. 82

Admit that neither Opposer nor another acting on Opposer's behalf has distributed any advertising or promotional material bearing the phrase AMERICA'S FAVORITE PASTA to areas of the United States west of the Mississippi River.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: 
G. Franklin Rothwell
Carla C. Calcagno
Attorneys for the Applicant
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

Dated: November 3, 2005

CERTIFICATE OF SERVICE

I hereby certify that on November 3, 2005, I served the foregoing APPLICANT'S FIFTH SET OF REQUESTS FOR ADMISSIONS NOS. 38-82 by causing a true copy thereof to be sent, via first class mail, postage prepaid to the following address:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108



Matthew Felten

NOV 07 2005

HOVEY WILLIAMS LLP

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

AMERICAN ITALIAN PASTA
COMPANY,

Opposer

v.

BARILLA G. E R. FRATELLI- SOCIETA
PER AZIONI,

Applicant.

 **COPY**

Opposition No. 91-161,373

**APPLICANT'S FOURTH SET OF REQUESTS FOR THE
PRODUCTION OF DOCUMENTS AND THINGS**

Pursuant to Rule 34 of the Federal Rules of Civil Procedure, as incorporated into the Rules of Practice, Applicant, Barilla G. E R. Fratelli - Societa Per Azioni ("Barilla"), requests Opposer, American Italian Pasta Company ("AIPC"), produce for inspection and copying the documents designated below at the offices of Barilla's counsel, Rothwell, Figg, Ernst & Manbeck, 1425 K Street, NW, Suite 800, Washington, DC 20005, c/o Carla C. Calcagno, within thirty (30) days of the service hereof or at such other time and place as the parties agree.

Definitions and Instructions

For purposes of these requests, Applicant adopts the Definitions and Instructions in Applicant's Third Set of Interrogatories to Opposer

For the convenience of the parties and the Board, each Request for Production should be quoted in full immediately preceding the response.

EXHIBIT

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REQUESTS

Request No. 28:

Copies (e.g. video tapes, CD ROMS or storyboards) of all television commercials in which the phrase AMERICA'S FAVORITE PASTA is either spoken or displayed visually.

Request No. 29:

Copies (e.g. tapes, or storyboards, or transcripts) of all radio advertisements in which the phrase AMERICA'S FAVORITE PASTA is spoken.

Request No. 30:

Documents sufficient to show the total number of times that television advertisements orally or visually displaying the phrase AMERICA'S FAVORITE PASTA have aired each year (or each month for periods less than a year) for each year for which Opposer claims use of the phrase.

Request No. 31:

Documents sufficient to show the total number of times that radio advertisements orally projecting the phrase AMERICA'S FAVORITE PASTA have aired each year (or each month for periods less than a year) for each year for which Opposer claims use of the phrase.

Request No. 32:

Documents sufficient to show the total number of times newspaper and magazine advertisements displaying the phrase AMERICA'S FAVORITE PASTA have appeared, each year (or for each month for periods less than a year) since 1997.

Request No. 33

Documents sufficient to show all geographic regions of the United States of America in which Opposer has aired television commercials orally or visually displaying the phrase America's Favorite Pasta, for each year for which Opposer claims use of the phrase.

Request No. 34

Documents sufficient to show all geographic regions of the United States of America in which Opposer has aired radio commercials orally displaying the phrase America's Favorite Pasta for each year, for which Opposer claims use of the phrase.

Request No. 35

Documents sufficient to show all geographic regions of the United States of America in which Opposer has distributed magazine and newspaper advertisements displaying the phrase America's Favorite Pasta, for each year for which Opposer claims use of the phrase

Request No. 36:

Representative samples of any advertisements referred to in response to Interrogatory No. 39.

Request No. 37

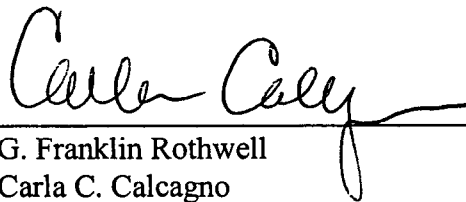
Representative copies of all nationally circulated advertisements in which Opposer or another on Opposer's behalf advertised or promoted the phrase AMERICA'S FAVORITE PASTA.

Interrogatory No. 38

Representative copies of all advertisements or commercials in which Opposer or another on Opposer's behalf advertised or promoted the phrase AMERICA'S FAVORITE PASTA for its Mueller's brand pasta products west of the Mississippi River.

Respectfully submitted,

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI

By: 

G. Franklin Rothwell
Carla C. Calcagno
ROTHWELL, FIGG, ERNST & MANBECK P.C.
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031
Attorneys for the Applicants

Dated: November 3, 2005

CERTIFICATE OF SERVICE

I hereby certify that on the 3rd day of November 2005, I served the foregoing
APPLICANT'S FOURTH SET OF REQUESTS FOR THE PRODUCTION OF DOCUMENTS
AND THINGS by causing a true copy thereof to be sent, in the manner indicated, to the
following:

Thomas H. Van Hoozer
Hovey Williams LLP
2405 Grand Blvd., Suite 400
Kansas City, MO 64108


Matthew Felten

docreq3